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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,289	01/23/2004	James D. Raymond	21257.00	4679

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EXAMINER

PLUMMER, ELIZABETH A

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,289

Applicant(s)

RAYMOND, JAMES D.

Examiner

Elizabeth A. Plummer

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) 12, 21 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 13-20 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/09/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17, 20, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hand et al. (US Patent 5,303,523).

a. Regarding claim 17, Hand et al. discloses a termite deterrent cap (11A,11B,11C) consisting essentially of a flat platform structure (22), having a top surface, a bottom surface and a peripheral edge (Fig. 4), one or more sidewalls (39) attached to the peripheral edge of the platform structure and extending downward at an outward angle from the peripheral edge of the platform structure (Fig. 3,4), wherein the cap is adapted to be placed on a post (column 1, lines 38-41) and wherein the cap is dimensioned to cover a top end of the post, such that

there is no contact between any inside surface of the sidewalls (39) and the exterior walls of the post.

b. Regarding claim 20, Hand et al. discloses that the cap can have a generally circular shape (column 4, lines 22-39) and can be adapted to be positioned on a generally cylindrical post (column 1, lines 38-41).

c. Regarding claim 24, Hand et al. discloses a method of inhibiting termites from damaging a wood structure, the method comprising positioning a cap (11A, 11B, 11C) on a post (column 1, lines 38-41), wherein the post is generally in a vertical position and the cap consists essentially of a flat platform structure (22) having a top surface, a bottom surface and a peripheral edge, and one or more sidewall (39) attached to the peripheral edge of the platform structure extending downward at an outward angle (Fig. 3, 4) from the peripheral edge of the platform structure, and wherein the cap is dimensioned to cover the top end of the post (column 1, lines 38-41), such that there is no contact between any inside surface of the sidewalls (39) and the exterior walls of the post (Fig. 3, 4).

d. Regarding claim 27, Hand et al. discloses that the cap can have a generally circular shape (column 4, lines 22-39) and can be adapted to be positioned on a generally cylindrical post (column 1, lines 38-41).

4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Davis (US Patent 2,112,229). Regarding claim 17, Davis discloses a termite deterrent cap (Fig. 1) consisting essentially of a flat platform structure having a top surface, a bottom surface and a peripheral edge, one or more sidewalls (4) attached to the peripheral edge of the

platform structure and extending downward at an outward angle from the peripheral edge of the platform structure (Fig. 2), where the cap is capable of being placed on a post and wherein the cap is dimensioned to cover a top end of the post (Fig. 2) such that there is no contact between any inside surface of the sidewalls and the exterior walls of the post (Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 11, 14-16 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al. (US Patent 5,303,523) in view of Muirhead (US Patent 2,165,500).

a. Regarding claim 9, Hand et al. discloses a termite deterrent cap (11A,11B,11C) in combination with a pier structure (200,200B), comprising a cement pier (column 1, lines 38-41) having a top end with exterior walls (Fig. 1,2,3), a cap (11A,11B,11C) consisting essentially of a topside, a periphery and sidewalls (39) having an inside surface (47) and extending downward at an outward angle from the periphery of the cap (Fig. 4), said cap being configured and dimensioned to cover the top end of said pier such that the inside surface of the sidewalls do not contact the exterior walls of said pier (Fig. 3). Hand et al. does not disclose that the pier includes a rod having a lower section centrally

embedded in the pier and an upper threaded section extending beyond the top end of the pier for connection to a support timber structure, the cap having a topside with a center aperture and the rod extending through the center aperture. However, it is notoriously well known in the art of insect barriers that a termite deterrent cap in combination with a pier structure can comprise a pier including a rod having a lower section centrally embedded in the pier and an upper threaded section extending beyond the top end of the pier for connection to a support timber structure, the cap having a topside with a center aperture and the rod extending through the center aperture. For example, Muirhead teaches a termite deterrent cap (8) in combination with a pier structure (6), the pier including a rod (10) having a lower section (11) centrally embedded in the pier (Fig. 1) and an upper threaded section extending beyond the top end of the pier for connection to a support timber structure (7) (Fig. 1), the cap having a topside with a center aperture and the rod extending through the center aperture (Fig. 1) in order to more securely and tightly fasten the cap in order to eliminate gaps between the pier and cap (page 1, lines 31-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hand et al. to include a pier with a rod having a lower section centrally embedded in the pier and an upper threaded section extending beyond the top end of the pier for connection to a support timber structure, the cap having a topside with a center aperture and the rod extending through the center aperture, such as taught by Muirhead, in order to enhance the effectiveness of the termite deterrent cap. Furthermore,

while Hand et al. does not disclose that the cap is made of plastic, it would have been a matter of obvious design choice to form the cap out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

b. Regarding claim 11, Hand et al. discloses that the cap and the pier can have a generally circular shape (column 4, lines 22-39).

c. Regarding claim 14, Hand et al. in view of Muirhead discloses the invention as claimed except for the sidewalls having a height of about 3 inches. It would have been a matter of obvious design choice to one of ordinary skill in the art at the same time the invention was made to form the sidewalls with a height of 3 inches, as Hand et al. in view of Muirhead is concerned with creating sidewall obstacles of an appropriate length. Furthermore, applicant has not disclosed the criticality of the sidewalls being 3 inches.

d. Regarding claim 15, the topside of the cap is substantially flat (Fig. 4).

e. Regarding claim 16, Hand further discloses that the termite deterrent can additionally comprise a bonding agent 202) between the pier and plastic cap.

While Hand in view of Muirhead does not disclose what type of bonding agent is used, it would have been a matter of obvious design choice to form the bonding agent out of caulk or asphalt, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for

the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

f. Regarding claim 25, Hand et al. does not disclose the cap has an aperture in the flat platform structure (22), the aperture adapted to accommodate a rod extending from a post. However, it is notoriously well known in the art that a termite cap can include an aperture adapted to accommodate a rod. For example, Muirhead teaches a termite deterrent cap (8) in combination with a pier structure (6), the pier including a rod (10) having a lower section (11) centrally embedded in the pier (Fig. 1) and an upper threaded section extending beyond the top end of the pier for connection to a support timber structure (7) (Fig. 1), the cap having a flat platform section with a center aperture and the rod extending through the center aperture (Fig. 1) in order to more securely and tightly fasten the cap in order to eliminate gaps between the pier and cap (page 1, lines 31-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hand et al. to include cap with an aperture in the flat platform structure for accommodating a rod extending from a post, such as taught by Muirhead, in order to enhance the effectiveness of the termite deterrent cap.

g. Regarding claim 26, the cap is inherently adapted to act as a surface on which a bottom plate can rest.

7. Claim 10 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al. (US Patent 5,303,523) in view of Muirhead (US Patent 2,165,500) as

applied to claim 9 above, and further in view of Watts, Jr. (US Patent 4,161,090).

Regarding claim 10, Hand et al. in view of Muirhead discloses the invention as claimed except for the periphery and the sidewalls of the cap coming together to form a chamfered outer edge. However, it is well known in the art that the periphery and sidewalls of a cap coming together can form a chamfered outer edge. For example, Watts, Jr. teaches a cap (14) on a pier (12) that has the periphery and the sidewalls of the cap coming together to form a chamfered outer edge (Fig. 1,3,9) in order to eliminate sharp edges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hand et al. in view of Muirhead to include chamfered outer edges, such as taught by Watts, Jr., in order to make an easier to handle and safer termite deterrent cap.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al. (US Patent 5,303,523) in view of Muirhead (US Patent 2,165,500), as applied to claim 9 above, and further in view of Carlson et al. (US Patent 6,223,463). Regarding claim 13, Hand et al. in view of Muirhead discloses the invention as claimed except for the cap being made of polyethylene. However, it is notoriously well known in the art that termite deterrent barriers can be made of polyethylene. For example, Carlson et al. teaches a termite barrier (20) made of polyethylene (column 8, lines 6-18) for its increased strength and flexibility. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hand et al. in view of Muirhead to make the cap out of polyethylene, such as taught by Carlson et al., in order to increase the durability of the termite deterrent cap. Furthermore, it would have been a matter of

obvious design choice to the cap out of polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al. (US Patent 5,303,523) in view of Watts, Jr. (US Patent 4,161,090). Regarding claim 19, Hand et al. discloses the invention as claimed except for the periphery and the sidewalls of the cap coming together to form a chamfered outer edge. However, it is well known in the art that the periphery and sidewalls of a cap coming together can form a chamfered outer edge. For example, Watts, Jr. teaches a cap (14) on a pier (12) that has the periphery and the sidewalls of the cap coming together to form a chamfered outer edge (Fig. 1,3,9) in order to eliminate sharp edges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hand et al. to include chamfered outer edges, such as taught by Watts, Jr., in order to make an easier to handle and safer termite deterrent cap.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al. (US Patent 5,303,523).

a. Regarding claim 22, Hand et al. discloses the invention as claimed except for the cap being made of polyethylene. However, it would have been a matter of obvious design choice to form the cap out of polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on

the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

b. Regarding claim 23, Hand et al. discloses the invention as claimed except for the sidewalls having a height of about 3 inches. It would have been a matter of obvious design choice to one of ordinary skill in the art at the same time the invention was made to form the sidewalls with a height of 3 inches, as Hand et al. is concerned with creating sidewall obstacles of an appropriate length.

Furthermore, applicant has not disclosed the criticality of the sidewalls being 3 inches.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US Patent 2,112,229) in view of Sharp (US Patent 6,103,973). Davis discloses a portion of the flat platform structure is removed (at 3) in order to accommodate a rod extending from a top surface of a post (Fig. 2). While Davis does not disclose that the cap comprised score lines in order to allow for the removal of this part, it is well known in the art that score lines can be provided in order to assist in the removal of a section. For example, Sharp teaches a scored portions (14, 18, 22, 30) on a flat portion in order to assist in the removal of a section. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis to use scored sections to remove the a portion from the structure, such as taught by Sharp, in order to make it easier to remove a section to accommodate a rod.

Response to Arguments

12. Applicant's arguments filed 11/09/2007 have been fully considered but they are not persuasive. Regarding applicants argument that Hand recites additional structure that touch the sidewalls of the pier, the sidewalls (39) of Hand do not touch the pier. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). In response to applicant's argument that is has a simplified structure in comparison to Hand, both caps consist of essentially the same structure; while Hand has extra parts, they do not change the basic and novel aspects of the claimed invention.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/J. CHAPMAN/
PRIMARY EXAMINER

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